

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MICHAEL E. MILLER

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Appeal No. 96-2294  
Application 08/278,558<sup>1</sup>

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ON BRIEF

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Before LYDDANE, PATE, and STAAB, Administrative Patent Judges.

PATE, Administrative Patent Judge.

DECISION ON APPEAL

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<sup>1</sup> Application for patent filed July 21, 1994. According to applicant, the application is a Continuation of Application 08/059,324, filed May 7, 1993.

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This is an appeal from the final rejection of claims 1 to 8 and 10 to 12. Claim 9 has been cancelled. These are the only claims in the application.

The invention is directed to a surgical instrument which has an outer cannula of tubular shape which is sized for insertion into a body. The outer cannula has a cutting opening at its distal end and is supported by a handpiece at its proximal end. The instrument further comprises an inner cannula which is slidably and concentrically disposed within the central barrel of the outer cannula. The inner cannula reciprocates inside the outer cannula and by reciprocation cuts tissue that protrudes through the opening in the outer cannula. In the first embodiment, the inner cannula has a hinge means to permit the cutting head to pivot slightly to give closer cutting. In the second embodiment, the body portion which extends from the cutting head to the connecting means on the handpiece is defined by an arc segment of preferably 70 to 80°. The arc segment gives the benefit of the hinge means of the first embodiment.

Claim 1 is further illustrative of the claimed subject matter and is appended to this decision.

The reference of record relied upon by the examiner as evidence of anticipation is:

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Hayafuji et al. (Hayafuji) 5,106,364 Apr. 21, 1992

The examiner has rejected claims 1 through 8 and 10 to 12 under 35 U.S.C. § 102(b) as anticipated by Hayafuji. According to the examiner, Hayafuji in Figure 14 discloses the claimed invention.

Pursuant to 37 CFR § 1.192(c)(7), the appellant states that the claims are to stand and fall in two groups. Group 1 consists of claims 1 through 8 and Group 2 consists of claims 10 to 12. Accordingly, we will limit our consideration to claims 1 and 10.

#### OPINION

We have carefully reviewed the rejection on appeal in light of the arguments of the appellants and the examiner. As a result of this review, we have determined that the claims on appeal are not anticipated by the Hayafuji reference. Therefore, the rejection of the claims on appeal will be reversed.

Additionally, pursuant to 37 CFR § 1.196(b), this Board enters a rejection of claims 10 through 12 under 35 U.S.C. § 112, second paragraph.

The inherent teaching of a prior art reference, a question of fact, arises both in the context of anticipation and obviousness. See In re Grasselli, 713 F.2d 731, 739, 218 USPQ 769, 775 (Fed. Cir. 1983). In relying upon the theory of

inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the alleged inherent characteristic necessarily flows from the teachings of the applied prior art. See In re King, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986).

With regard to claim 1, we are of the view that the examiner has not provided factual evidence or technical reasoning to show that the arcuate connecting region in Figure 14 of Hayafuji necessarily has the characteristic of a hinge portion. In a situation such as this wherein there is a mere possibility that the prior art reference functions as claimed, the examiner has not discharged his or her initial burden of proving inherency.

Furthermore, with respect to claim 1, we note that it is altogether unclear from the Hayafuji reference and particularly Figure 14, which the examiner references, as to whether the smallest width (as defined by appellant in the claim) of the bow tie openings 180a is less than the length (as defined by appellant in the claim) of the cutting head, i.e., the first annular portion on the inner cannula of Hayafuji. This is one of appellant's argued differences in the appeal brief, and it is not addressed at all by the examiner in the examiner's answer. It is our determination that there is little evidence this claimed

dimensional relationship is satisfied by the Hayafuji reference.

Regarding claim 10, we have entered a rejection of this claim under 35 U.S.C. § 112, second paragraph, infra. However, to the extent that claim 10 is understood, we reverse the 35 U.S.C. § 102 rejection thereof. We note that Figure 14 of Hayafuji appears to satisfy the limitation in claim 10 of said body portion being defined by an arc segment of less than 180°. However, with respect to the unaddressed dimensional limitation, just as with respect to claim 1, the examiner has provided little evidence that Hayafuji satisfies this argued limitation. Therefore, to the extent that the claim is understood, it is clear that Hayafuji is not anticipatory thereof.

Pursuant to 37 CFR § 1.196(b), claims 10 through 12 are rejected for failure to comply with the second paragraph of 35 U.S.C. § 112.

The test of whether a claim complies with § 112, second paragraph, is:

whether the claim language, when read by a person of ordinary skill in the art in light of the specification, describes the subject matter with sufficient precision that the bounds of the claimed subject matter are distinct.

In re Merat, 519 F.2d 1390, 1396, 186 USPQ 471, 476 (CCPA 1975).

We note that in the ultimate subparagraph of claim 10, the claim

states "further wherein said cutting head portion pivots about said hinge portion . . . ." Therefore, we are unable to determine whether appellant intended to recite that a portion of the body portion acts as a hinge, or whether appellant intended to recite no hinge whatsoever and rely on the structure of the limited arc segment alone in defining the invention of the second embodiment. As noted above, in these circumstances, we are unable to determine the bounds of the claimed invention.

SUMMARY

The rejection of claims 1 through 8 and 10 to 12 under 35 U.S.C. § 102 has been reversed. Pursuant to 37 CFR § 1.196(b), the Board has entered a rejection of claims 10 through 12 under 35 U.S.C. § 112, second paragraph.

Any request for reconsideration or modification of this decision by the Board of Patent Appeals and Interferences based upon the same record must be filed within one month from the date of the decision. 37 CFR § 1.197. Should appellant elect to have further prosecution before the examiner in response to the new rejection under 37 CFR § 1.196(b) by way of amendment or showing of facts, or both, not previously of record, a shortened statutory period for making such response is hereby set to expire two months from the date of this decision.

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No time period for taking any subsequent action in  
connection with this appeal may be extended under 37 CFR  
§ 1.136(a).

REVERSED 37 CFR § 1.196(b)

	)	
WILLIAM E. LYDDANE	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
WILLIAM F. PATE, III	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
LAWRENCE J. STAAB	)	
Administrative Patent Judge	)	



APPENDIX

1. A surgical cutting instrument for use in cutting tissue within an anatomical space, comprising:

an outer tubular member sized for percutaneous insertion into the anatomical space, said outer tubular member defining a central bore along the length of said outer tubular member and having a proximal end and a distal end, said outer tubular member further defining a cutting opening having a first cutting edge adjacent said distal end and sized to receive tissue therethrough, said cutting opening having a width dimension along the length of said outer tubular member;

a handpiece for supporting said outer tubular member at said proximal end;

a cutting member slidably disposed within said central bore of said outer tubular member, said cutting member including:

a tubular cutting head portion defining an end opening and a second cutting edge at said end opening, said cutting head portion having a length dimension along the length of said cutting member that is at least equal to said width dimension of said cutting opening;

a tubular body portion extending through said central bore from a distal end adjacent said cutting head portion to a proximal end adjacent said handpiece, wherein said head portion and said body portion have substantially the same outer diameter, which outer diameter is sized relative to the inner diameter of said outer tubular member to provide a close running fit; and

a hinge portion connecting said cutting head portion with said body portion to permit pivoting of said cutting head portion relative to said body portion; and

connecting means within said handpiece for connecting said body portion of said cutting member to a source of reciprocating motion to reciprocate said cutting member within said outer tubular member so said second cutting edge traverses said first cutting edge,

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wherein said cutting head portion pivots about said hinge portion toward said cutting opening when said cutting head contacts tissue within said outer tubular member to form an essentially zero clearance between said second cutting edge and said first cutting edge as said cutting member is advanced toward said distal end of said outer tubular member.

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